

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed: 9/28/04

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

National Association of Realtors
v.
Titan International, Inc.

Opposition No. 91125778
to application Serial No. 76321648
filed on October 4, 2001

Michael F. Thiel, Esq. for National Association of Realtors.

Daniel A. Rosenberg of Davis, Brown, Koehn, Shors & Roberts
for Titan International, Inc.

Before Hanak, Chapman and Quinn, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Titan International, Inc.
to register the mark REALTOR for "tires."¹

Registration was opposed by National Association of
Realtors under Section 2(d) of the Trademark Act on the
ground that applicant's mark, when applied to applicant's
goods, so resembles opposer's previously used and registered

¹ Application Serial No. 76321648, filed October 4, 2001,
alleging first use anywhere and first use in commerce on January
29, 1999.

marks REALTOR, REALTOR.COM and REALTOR VIP for a variety of services, as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations in the notice of opposition.²

The record consists of the pleadings; the file of the involved application; certified copies of opposer's pleaded registrations, dictionary definitions of "Realtor," excerpts from printed publications, printed publications in their entirety, excerpts of articles retrieved from the NEXIS database, and excerpts of web sites taken from the Internet, all introduced by way of opposer's notices of reliance; and third-party registrations made of record by applicant. The parties filed briefs.³ An oral hearing was not requested.

There is no issue as to opposer's priority in view of opposer's registrations of its REALTOR marks which opposer has made of record. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). The pleaded registrations made of record are as follows:

REALTOR as a collective trademark for "brokerage of real estate, industrial brokerage, farm brokerage, mortgage brokerage, in the appraisal of real estate, management of

² Applicant set forth certain allegations, including that opposer's mark is generic, in its answer as "affirmative defenses." No counterclaim was ever filed against any of the pleaded registrations and, accordingly, no consideration will be given to the allegation of genericness.

³ Opposer's motion to extend its time to file a reply brief, to which applicant consented, is granted. Accordingly, opposer's reply brief is considered timely filed.

real estate, in the building of structures on real estate, in the subdivision of real estate properties, and in community planning for the development of raw land and slum clearance areas"⁴; REALTOR.COM (".COM" disclaimed) for "providing an online data base which features information regarding real estate listings which are carried by the applicant's members"⁵; and REALTOR VIP for "association services, namely, developing group purchasing programs and identifying vendors who have agreed to provide discounts or other enhancements on their goods and services for applicant's members," and "financial and insurance services for members of the applicant, consisting of a program encompassing retirement and investment offerings, namely, underwriting property/casualty insurance, underwriting life/health insurance, financial planning, funds investment and investment consultation."⁶

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or

⁴ Registration No. 519789, issued January 10, 1950; renewed.

⁵ Registration No. 2291873, issued November 16, 1999.

⁶ Registration No. 2615872, issued September 3, 2002.

dissimilarities between the goods and/or services.

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Applicant's mark is identical to the REALTOR mark of opposer. Further, applicant's mark is substantially similar to opposer's REALTOR.COM and REALTOR VIP marks. Both of these latter marks of opposer are dominated by REALTOR which, again, is identical to applicant's mark.

We turn next to the second du Pont factor, that is, the similarity or dissimilarity of the parties' respective goods and/or services. As has been often stated, it is not necessary that the goods and/or services of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and In re International Telephone & Telegraph Corp., 197 USPQ2d 910 (TTAB 1978). Moreover, the greater the degree of

similarity between the parties' marks, the lesser the degree of similarity between the parties' goods and/or services that is required to support a finding of likelihood of confusion. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); and In re Opus One Inc., 60 USPQ2d 1812 (TTAB 2001).

Insofar as opposer's registrations cover real estate related services, opposer has not established that these services and tires are related. And, indeed, we find that these real estate services and tires are not commercially related. Although opposer's primary services relate to real estate, opposer is quick to point out that "[p]articularly relevant to the confusion likely to arise out of Applicant's use of its mark is Opposer's membership service program entitled the REALTOR VIP member benefits program." (Brief, p. 7). According to opposer, it, like many other trade and professional membership associations, has established an affinity program for the benefit of its members. The programs, opposer claims, are a natural and expected function of such membership organizations. Opposer states that these programs provide special benefits or value to the members who purchase a vendor's product or service, while at the same time providing licensing income to the membership organization through the vendor's use of opposer's marks. One of opposer's programs is related to the purchase of

automobiles whereby a member participant qualifies for a \$500 cash allowance on certain models. Opposer goes on to argue as follows:

[A]lthough some of the products and services included in Opposer's REALTOR VIP program are directly related to the real estate business (e.g., professional liability insurance), other products and services offered by REALTOR VIP vendors are not related to real estate (e.g., museum membership, flowers and cars). Thus, in assessing the likelihood of confusion it is insufficient to compare real estate services and programs with tires as Applicant has done. Instead, the assessment must consider whether members of Opposer, having seen the REALTOR Family marks used in connection with the purchase of consumer products and services unrelated to real estate such as museum membership, flowers and cars, would be likely to believe that the use of the same mark in connection with another consumer product, namely, tires, might be confused so as to believe incorrectly that those tires are associated with Opposer through Opposer's REALTOR VIP membership benefits program.

To be sure, Opposer has not and does not claim that others would be likely to believe, incorrectly, that Opposer manufactures or sells tires. What Opposer does claim, and what is in fact almost certainly true, is that members of Opposer will misunderstand Applicant's use of the REALTOR mark on tires to be pursuant to Applicant's participation in the REALTOR VIP program or other program of Opposer, and thus indicative of the existence of a relationship between Applicant and Applicant's tires and Opposer. Members of Opposer are likely to see a direct parallel between Applicant's use of the REALTOR mark on tires and Opposer's

allowing its REALTOR Family of marks to be used to identify other products or services of third parties whom Opposer is recommending to its members. (Brief, pp. 8-9).

Thus, we will focus our attention, as opposer has done, on the likelihood of confusion between opposer's REALTOR VIP mark and its association services related to group purchasing programs rendered thereunder, and applicant's mark REALTOR for tires.

The fact that applicant's mark may call to mind opposer's REALTOR mark is not dispositive of the likelihood of confusion claim herein. Likelihood of confusion under Section 2(d) means more than the likelihood that relevant purchasers will recall a mark on seeing the same mark used by another.⁷ It must also be established that "there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark." *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982). See also: *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982), *aff'g* 211 USPQ 165 (TTAB 1981); *In re Ferrero*, 479

⁷ See generally 4 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 24:70 (4th ed. 2001): "Difference between dilution and likelihood of confusion." A dilution claim was not raised in the present proceeding.

F.2d 1395, 178 USPQ 167 (CCPA 1973); Viacom International Inc. v. Komm, 46 USPQ2d 1233 (TTAB 1998); Original Appalachian Artworks, Inc. v. Streeter, 3 USPQ 1717 (TTAB 1987); and American Express Co. v. Payless Cashways, Inc., 222 USPQ 907 (TTAB 1984). Here, the record falls short of establishing the reasonable basis contemplated by the Federal Circuit. As applicant points out: "The only connection between Opposer, and its marks, and the goods/services of the others under its VIP program, is the discount provided and not the goods/services themselves. In other words, what Opposer provides as a benefit to its members is the discount, and not the actual goods/services. Otherwise, there is no connection between Opposer and the source of the discounted good/service." (Brief, pp. 7-8).

A factor mentioned by opposer, and one that is significant if established, is fame. According to opposer, its REALTOR mark "enjoys significant fame within the real estate field." (Reply Brief, p. 10).⁸ Opposer points to its long use of the mark; its current membership in excess of 900,000 members (which, according to opposer, makes it the largest professional association in the country); and

⁸ In its main brief, opposer cites to five relevant du Pont factors as supporting its claim of likelihood of confusion in this case. (Brief, p. 9). Conspicuously absent from this discussion in the main brief is a reference to the du Pont factor of fame.

its ongoing advertising campaign that, in 2002, exceeded \$15 million.⁹

Although it may be likely opposer could establish that its REALTOR mark is famous in the real estate field, the record before us simply falls short of establishing this fame. See *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998). Cf. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). In any event, even if it were shown that

⁹ Opposer did not take any testimony in this proceeding, but rather chose to introduce its case by way of notices of reliance. Although applicant has not questioned the facts underlying opposer's assertion of fame, the manner in which these facts were introduced is questionable. With respect to its purported long use of the mark REALTOR, opposer has pointed to its dates of first use set forth in its registrations. We would point out, however, that the allegation in a registration of a date of use is not evidence on behalf of the registrant in an inter partes proceeding; to be relied upon by the registrant, a claimed date of use of a mark must be established by competent evidence. Trademark Rule 2.122(b)(2). See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). See also TBMP § 704.04 (2d ed. rev. 2004). Further, opposer has relied upon printed publications ("REALTOR" magazine) to establish membership numbers and 2002 advertising expenditures. However, printed publications are admissible and probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters. See *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n. 5 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Food Producers, Inc. v. Swift & Co.*, 194 USPQ 299, 301 n. 2 (TTAB 1977); and *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407, 408 n. 5 (TTAB 1975). See also TBMP § 704.08 (2d ed. rev. 2004). As indicated above, these facts, even if true, fail to establish the fame of opposer's REALTOR mark.

opposer's REALTOR mark is famous for its real estate-type services, that fame is unlikely to extend to REALTOR VIP for specifically distinct services such as those listed in Registration No. 2615872, "association services, namely, developing group purchasing programs and identifying vendors who have agreed to provide discounts or other enhancements on their goods and services for applicant's members." There is no evidence of record that opposer has marketed tires (or any other consumer product) under the REALTOR marks, nor is there any evidence to suggest that other membership organizations with similar group purchasing programs also market products, both under the same or similar mark. Simply put, opposer has not shown that it has become known for the sale of any consumer products like tires, or that its REALTOR mark has become identified with such goods. See *G. H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635, 1639 (Fed. Cir. 1990) [strength of opposer's mark for sparkling wines does not extend to other alcoholic beverages such as beer]. To hold otherwise would result in giving opposer a right in gross which is contrary to principles of trademark law and to Section 2(d) of the Trademark Act. See *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc.*, supra. See also *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003).

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For the reasons discussed above, we find that the relatively sparse evidence of record does not support a finding that there is a likelihood of confusion between any of opposer's marks and applicant's mark. Perhaps on a more complete record, a different result would pertain, but we are, of course, constrained to make our decision based on the pleaded claim and the particular record before us in any given case.

Decision: The opposition is dismissed.